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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,640	02/10/2004	Alexander B.H. Bakker	DX0763XB1	1877
28008	7590	11/29/2006		
DNAX RESEARCH INC. LEGAL DEPARTMENT 901 CALIFORNIA AVENUE PALO ALTO, CA 94304			EXAMINER O'HARA, EILEEN B	
			ART UNIT 1646	PAPER NUMBER

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,640

Applicant(s)

BAKKER ET AL.

Examiner

Eileen B. O'Hara

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1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/23/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 21-30 are pending in the instant application.

Election/Restrictions

2. Applicant's election of Group II in the reply filed on Sept. 27, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Applicant's further election with traverse of Group A, human DAP12 is acknowledged. The traversal is on the ground(s) that the human and mouse DAP12 are approximately 70% identical, and searching binding compositions for both proteins would not be a burden. This is found persuasive and both human and mouse binding compounds will be examined.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6 and 10-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 7-9 are currently under examination.

Specification

- 3.0 The disclosure is objected to because of the following informalities:

- 3.1 37 C.F.R. §1.821(d) states:

Where the description or claims of a patent application discuss a sequence that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section,

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reference must be made to the sequence by use of the sequence identifier, preceded by "SEQ ID NO:" in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application.

The instant specification needs to be amended so that it complies with 37 C.F.R. § 1.821(d) which requires a reference to a particular sequence identifier (SEQ ID NO:) be made in the specification and claims wherever a reference is made to that sequence. For example, on page 23, line 1, sequences are referred to as Tables and not SEQ ID NO, and on page 15, the human and mouse sequences are not identified by SEQ ID NO. Also, claim 2 refers to MDL-1 protein of Table 3. For rules interpretation Applicant may call (703) 308-1123. See M.P.E.P. 2422.04.

Applicants are required to amend the specification and claims to comply with 37 C.F.R. §1.821(d).

3.2 On page 9 of the specification, line 37, states the alignment of primate and rodent DAP12 protein sequences (SEQ ID NO: 2 and 4), but SEQ ID NO: 4 should be SEQ ID NO: 6, for rodent DAP12.

Appropriate correction is required.

3.3 The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Binding compounds to DAP12 proteins.

Priority

4. Applicant is reminded of the following requirement:

In a continuation or divisional application (other than a continued prosecution application filed under 37 CFR 1.53(d)), the first sentence of the specification or application data sheet (37 CFR

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1.76) should include a reference to the prior application(s) from which benefit of priority is claimed, and also the status. See 37 CFR 1.78. This application is a divisional of USSN 10/191,732, now U.S. Patent No. 6,953,843, which should be included in the first sentence.

Information Disclosure Statement

5.1 The information disclosure statement (IDS) submitted on June 23, 2004 has been considered by the examiner.

5.2 The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Objections

6. Claims 7-9 are objected to because of the following informalities:

6.1 Claim 7 encompasses nonelected inventions, which should be deleted.

6.2 Claim 7 depends from a nonelected invention, polypeptide of SEQ ID NO: 2 or 6.

Independent claim 7 should recite that the binding compound specifically bind to the polypeptide of SEQ ID NO: 2 or 6.

Appropriate correction is required.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7-9 are indefinite because claims 7 encompasses a *mature* sequence of SEQ ID NOS: 2 or 6, but there is no mature sequence identified in the specification.

Claims 7-9 are indefinite because claim 7 encompasses a DAP12 polypeptide which is a “natural” sequence”. It is not clear what is meant by the term “natural” sequence, or how one of ordinary skill in the art would be able to determine if a sequence is “natural” or not by looking at it.

Claims 7-9 are also indefinite because the polypeptide of claim 2 comprises a charged residue in “*a*” transmembrane domain, which indicates that there is more than one transmembrane domain, but there is only one transmembrane domain in the protein.

Pertinent Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure, Bristol-Myers Squibb Company, et al., U.S. Patent Application Publication No. 20030171742, which discloses a protein (SEQ ID NO: 79) that is identical to the protein of SEQ ID NO: 2 of the instant application. This is not considered prior art, since the priority date of the instant application precedes that of the reference, and is cited as the closest art.

Conclusion

9. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (571) 272-0878. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Nichol can be reached at (571) 272-0835.


The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

Eileen B. O'Hara, Ph.D.

Patent Examiner


EILEEN B. O'HARA
PRIMARY EXAMINER